



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Franklin Grosvenor, et al.

Group Art Unit No.: 3623

Serial No.: 09/846,134

Filed on: April 30, 2001

For: METHOD AND APPARATUS PROVIDING A
SUPPLY CHAIN MANAGEMENT SYSTEM
USEFUL IN OUTSOURCED
MANUFACTURING

Mail Stop Amendment
Commissioner of Patents
P.O. Box 1450
Washington, D.C. 20231

REPLY TO OFFICE ACTION

Sir:

In reply to the first Office Action mailed April 27, 2005, the shortened statutory period for which runs until May 27, 2005, please reconsider the subject application in light of the amendments and remarks herein.

I. ELECTION OF SPECIES

The Office Action presented a requirement to elect a single disclosed species for prosecution. The Office Action apparently contends that each of Claims 6-18 represents one of thirteen (13) distinct species. Application elects, with traverse, to prosecute the species of Claim 12. Claim 12 corresponds to the elected species.

II. TRAVERSAL OF ELECTION REQUIREMENT

Applicants respectfully traverse the election requirement for the following reasons.

The MPEP repeatedly states that a fundamental criterion for a proper requirement of restriction is that there "must be a serious burden on the examiner if restriction is required ... if

the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” *See MPEP 803.* However, the Office Action makes no showing of any burden on the Examiner, much less a serious burden.

No serious burden exists in this case. The Office Action gives no indication that the subject matter of Claims 6-18 is separately classified, separately recognized in the art, or that the claims are so numerous or complex as to require a seriously burdensome search or other substantive examination. A search for art pertaining to automated application supply chain rules is likely to uncover any prior art that could possibly be pertinent to Claims 6-18. Indeed, with the automated, keyword-based search tools available to Examiners, and the high level of skill among Examiners, searching or opining on Claims 6-18 cannot present any serious burden. The present application contains a reasonable number of claims. Therefore, the amount of time required for search or substantive examination does not represent a serious burden.

Moreover, the Office Action makes no attempt to present any substantive rationale as required by MPEP 816, or under the outline provided in MPEP 817. The only rationale given in the Office Action is two conflicting statements of the generic feature. In section (1.), the Office action states that Claims 6-18 “are distinct species of the generic feature of wherein periodically applying rules comprises.” In Section (2.), second paragraph, the Office Action states that the claims “are distinct species of the generic feature of wherein periodically applying rules comprises escalating comprises.” These statements conflict, and the latter is not understandable because neither Claim 1 nor Claim 5 (from which Claims 6-18 depend) contain a reference to “escalating.” The statements are also conclusory and do not meet the standard of MPEP 816-817.

The mere absence of a supporting rationale is enough to establish that the election requirement has been made in error. The absence of a supporting rationale also tends to establish that the subject matter of Claims 6-18 is easily examined at the same time. Applicants are not, by this statement, contending or admitting that Claims 6-18 are not patentably distinct. Applicants respectfully submit, however, that the failure of the Office Action to present a substantive technical or administrative reason for election is an admission that election is not proper, and that all the claims are easily examined together.

In addition, a heavy burden falls on the Applicants if the election requirement is maintained. An election requirement that could potentially require Applicants to file twelve (12) additional applications, one for each of Claims 6-18 that is not elected herein imposes an unreasonable resource burden on the Applicants, and would lead to a needless compounding of Office resources.

For all the foregoing reasons, reconsideration and withdrawal of the election requirement are respectfully requested.

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III. CONCLUSIONS & MISCELLANEOUS

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: May 9, 2005



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On May 9, 2005 By Treas. Jurt